

### Remarks

Reconsideration of the present application is respectfully requested.

The indication that claims 3-5, 7, 9, 10, 13, 14, 17, 19 and 20 are allowable if rewritten is acknowledged with appreciation.

The rejection of claims 1, 2 and 6 under 35 USC 102(b) as being anticipated is overcome by the amendment to claim 1. In particular, claim 1 now features approximating a runout compensation value. However, Ohba only discloses "offset correction current for removing influence of an external force on the VCM." Col. 10, lines 49-53. An external force is disclosed as a mechanical biasing force. Col. 9, lines 29-32.

Since Ohba does not identically show the claim 1 feature of approximating a runout compensation value, claim 1 is not anticipated and is therefore allowable. Claims 2 and 6 are also allowable due to their dependence on allowable claim 1.

The rejection of claims 8, 11, 12, 15, 16 and 18 under 35 USC 103(a) as being unpatentable over Ohba in view of Ellis is respectfully traversed.

Claim 8 features summing the approximate runout compensation value for the destination position with a write-in repeatable run-out compensation value. As explained above, Ohba does not identically show a runout compensation value. And Ohba does not suggest such a value. Ellis has the same deficiencies. So even if Ohba and Ellis are combinable as alleged in the Office Action, the claim 8 feature of summing the approximate runout compensation value for the destination position with a write-in repeatable run-out compensation value. Therefore, claim 8 is not obvious and is allowable.

For claims 11, 12, 15, 16 and 18, it is insufficient that the prior art disclosed the components of the patented device, either singularly or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. See Northern Telecom Inc. v. Datapoint Corp., 15 USPQ2d 1321 (Fed. Cir. 1990). The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be

solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

The Office Action makes this statement to support the obvious rejection, "It would have been obvious to one of ordinary skill in the art at the time of the invention to include such a feature, taught by Ellis, in the arrangement as taught by Ohba to allow for the compensation of write-in repeatable run-out." That statement, however, fails to support this rejection.

Nowhere in either Ohba or Ellis is there an explicit teaching or suggestion "to include such a feature, taught by Ellis, in the arrangement as taught by Ohba to allow for the compensation of write-in repeatable run-out."

Without that explicit teaching or suggestion, the Office Action may show some suggestion or teaching explicitly either from the knowledge of one of ordinary skill in the art combined with the teachings of the applied references or the nature of the problem to be solved. Yet the Office Action neither provides any evidence that knowledge of a skilled artisan combined with the teachings of the applied references nor provides any evidence that the nature of the problem to be solved by the present invention would render obvious to the skilled artisan "to include such a feature, taught by Ellis, in the arrangement as taught by Ohba to allow for the compensation of write-in repeatable run-out."

Without that explicit teaching or suggestion, or evidence described above, the Office Action can still support this obvious rejection by providing evidence that the prior art as a whole implicitly shows "to include such a feature, taught by Ellis, in the arrangement as taught by Ohba to allow for the compensation of write-in repeatable run-out." The test for an implicit showing, as stated above, is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. But the Office Action has provided no evidence that Ohba, Ellis, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved (of claim 11) as a whole would have suggested to the skilled artisan "to include such a feature, taught by Ellis, in the arrangement as taught by Ohba to allow for the compensation of write-in repeatable run-out." Without that evidence, the Office Action statement quoted above is merely conclusory. Yet broad conclusory statements standing alone are not "evidence." See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

In conclusion, the Office Action has not shown any explicit teaching or suggestion, or relevant evidence to support the obvious rejection for claim 11. As a consequence, claim 11 is not obvious and is therefore allowable. Claims 12, 15, 16 and 18 are also allowable due to their dependency on allowable claim 11.

### Conclusion

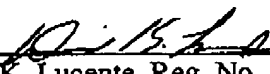
This Reply is believed to be responsive to all points raised in the Office action. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

Seagate Technology LLC  
(Assignee of the Entire Interest)

Date

3/4/05

  
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